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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/768,415

01/30/2004

Philip Emery

7015

6942

7590

01/26/2007

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/768,415

Applicant(s)

EMERY ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25,27,28,30,31 and 33-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25,27,28,30,31 and 33-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response along with the Request for Continued Examination (RCE) filed on 12/29/2006 has been fully considered.
2. Claims 1-24, 26, 29 and 32 are canceled, claims 25, 27, 28, 30, 33, 34, 40 and 43-45 are amended, and thus claims 25, 27, 28, 30, 31 and 33-46 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25, 27, 28, 30, 31, 33-39 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 5,190,609) in view of Ast (US 6,248,427 B1) and Huguen et al. (US 5,747,192).
5. Lin discloses a heat shrinkable label comprising a backing sheet (col. 2, line 42), a first pressure sensitive adhesive (PSA) on the backing layer (col. 2, line 56), a first shrinkable layer on the first PSA (col. 2, line 44), graphics on the first shrinkable layer (col. 3, line 23), a second pressure sensitive adhesive (PSA) on the graphics (col. 3, line 32), and a second shrinkable layer on the second PSA (col. 2, line 44). The shrinking temperature of the first and second shrinkable layers is 240-250 degree F (col. 3, line 56), and the layers are made of polypropylene (col. 2, line 45). The thickness of the

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shrinkable layer is 1.25 mils (col. 4, line 63). With respect to the claimed stiffness value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229.

Since the Lin reference teaches substantially identical material, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Lin does not teach the use of polystyrene as the shrinkable layers.

6. Ast teaches adhesive label comprising a shrinkable cover foil that can be made of polypropylene, polystyrene, polyethylene or polyester (col. 3, lines 37-42).

7. Lin and Ast are analogous art because they are from the same field of endeavor that is the heat shrinkable label art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use polystyrene to make the shrinkable layers of Lin since the examiner takes Official Notice of the equivalence of polyethylene and polystyrene for their use in the heat shrinkable art and the selection of any of these known equivalents to make the shrinkable layers would be within the level of ordinary skill in the art.

8. With respect to the shrink and growth direction of the label, it is well known in the shrinkable label art for the label to be applied on a battery to shrink up to 60% in the direction normal to the axis of the battery, and to shrink -2 to +5% in the axial direction,

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wherein negative shrinkage means elongation. Such characteristics are well known in the art before the claimed invention (see col. 5, lines 19-36 of Hughen).

9. Claims 25, 27, 28, 30, 31, 33-43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ast (US 6,248,427 B1) in view of Lin et al. (US 5,190,609) and Hughen et al. (US 5,747,192).

10. Ast discloses an adhesive shrinkable label comprising a carrier (col. 4, line 17), an adhesive on the carrier (col. 4, line 15), a carrier material on the adhesive (col. 4, lines 7-13), wherein the carrier material comprises metallic layer and non-metallic layer, a laminating adhesive on the carrier material (col. 5, line 52), imprints on the laminating adhesive, and a shrinkable cover foil on the imprint (col. 3, line 39). The shrinkable cover foil comprises polyethylene; however, Ast does not teach the shrinking temperature value of the shrinkable cover foil. The shrinking temperature value would fall within the claimed range because Lin teaches the use of polyethylene as the shrinkable layer and this layer shrinks at a range of 240-250 degree F (col. 3, line 56 of Lin). The shrinkable cover foil has a thickness of 20-70 micrometer (0.02-0.07mm) (col. 3, line 43 of Ast). Ast discloses that the shrinkable foil can carry additional layers on top and bottom side (col. 3, line 63). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a transparent protective layer on the external side of the shrinkable cover foil so as to protect the foil during manufacturing, packaging, and/or transportation because adding a protective layer is on a laminate and/or a label is well known in the laminate and/or label art.

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11. With respect to the shrink and growth direction of the label, it is well known in the shrinkable label art for the label to be applied on a battery to shrink up to 60% in the direction normal to the axis of the battery, and to shrink -2 to +5% in the axial direction, wherein negative shrinkage means elongation. Such characteristics are well known in the art before the claimed invention (see col. 5, lines 19-36 of Hughen).

Response to Arguments

12. Applicant argument is based on that the independent claim 25 defines a label construction that has not previously been claimed and that is neither disclosed nor suggested by the references of record, either when viewed singly or in the combinations suggested by the examiner. That argument is not persuasive because Applicant has failed to point out the elements of claim 25 that have not been disclosed or suggested by the references of record, either when viewed singly or in the combination.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.


14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private.PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS

January 20, 2007.


BETELHEM SHEWAREGED
PRIMARY EXAMINER